

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Patent No. : 6,112,514  
Issued : September 5, 2000  
Application No. : 09/159,634  
Filed : September 24, 1998  
For : Fan Noise Reduction From Turbofan Engines Using Adaptive Herschel-Quincke Tubes

**REQUEST FOR RECONSIDERATION OF PETITION  
TO ACCEPT UNAVOIDABLY DELAYED  
PAYMENT OF MAINTENANCE FEE UNDER 37 C.F.R. § 1.378(b)**

Mail Stop Petition  
Commissioner for Patents P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is a Request for reconsideration of the Petition under 37 C.F.R. § 1.378(b) in the above-identified patented file. The 23 October 2012 Decision of Senior Attorney Paul Shanoski of the Office of Petitions finds Petitioner's 23 January 2012 Petition to be deficient and notes eleven points that need further response from Petitioner. Each of these eleven is quoted and responded to as follows.

The first point in the Decision states that

1. Petitioner has not sufficiently identified the error that was the cause of the delay at issue in regards to VTIP: the petition does not indicate the date on which Ms. Lucas made the erroneous entry of "Paid 8/9/06." Moreover, Petitioner has not identified the error that was the cause of the delay at issue in regards to the Whitham law firm. The record is silent as to why the 7-1/2 year maintenance fee was not submitted during the period of time which the Whitham law firm was responsible for the tracking a payment of the same. (Decision, pages 8 and 9 of 11.)

The error that was the cause of the delay is the erroneous entry of “Paid 8/9/06” by Debra Lucas. This error is identified at pages 7-8 of the Petition and it is discussed in the Declarations of Mark Coburn and Debra Lucas (filed with the Petition on 23 January 2012). A Supplemental Declaration of Mark Coburn is submitted herewith and confirms that the erroneous entry was made on or about 8/9/06 which is the date reflected in the entry itself. Mark Coburn’s supplemental declaration is submitted with this Request For Reconsideration and his statement at paragraph 6 identifies the error by stating

The error that was the cause of the delay is the erroneous entry of “Paid 8/9/06” by Debra Lucas. This error resulted from her noting the 09 August 2006 letter from Michael Whitham (copy filed with the 23 January 2012 petition) informing of payment of the EP annuity wherein she erroneously docketed “Paid 8/9/06” for the US ‘514 patent rather than for the European application. At the time of the error (on or about 8/9/06) Debra Lucas and I were the only persons responsible for entry of information into the VTIP tracking system (the Inteum C/S system used at VTIP). I believe Debra Lucas made the erroneous “Paid 8/9/06” entry and Debra (in her declaration filed with the 23 January 2012 petition) confirms that “I erroneously entered the “Paid 8/9/06” entry on the VTIP Inteum C/S tracking report of the ‘514 patent (copy attached as Exhibit A) and I erroneously entered the “Paid 8/9/06” entry on the Inteum C/S IP Assets screen shot for Tech ID 97.058.” (Debra Lucas declaration at paragraph 8.) This erroneous “Paid 8/9/06” entry is the error that caused the failure to pay the second maintenance fee for the ‘514 patent. As stated in my declaration (filed with the 23 January 2012 petition) “If the “Paid 8/9/06” indicator had not been in the record I believe I would have ordered payment of the US maintenance fees and the ‘514 patent would not have expired. I believe Debra Lucas made the erroneous “Paid 8/9/06” entry....” After taking over maintenance fee payment responsibilities (on or about 01 May 2008) I regularly (at least monthly) reviewed the due dates for maintenance fees to ensure timely payment and did so during the time the second maintenance fee for the ‘514 patent could have been paid with a surcharge (i.e., up to 05 September 2008) but the erroneous “Paid 8/9/06” entry led me to believe that the second maintenance fee for the ‘514 patent had been paid and therefore need not be paid.

Regarding the unidentified error “that was the cause of the delay at issue in regards to the Whitham law firm,” there was no error at the Whitham law firm so none can be identified. The Whitham law firm was not responsible to pay the second maintenance fee (7-1/2 year

maintenance fee) because they were instructed to not pay any maintenance fee without specific instructions and as stated in the Declarations of Mark Coburn and Michael Whitham (filed with the Petition on 23 January 2012) no instructions to pay the second maintenance fee were ever sent to the Whitham firm. The above-noted Supplemental Declaration of Mark Coburn confirms that the Whitham firm was instructed by VTIP not to pay any maintenance fee without specific instructions to do so. As explained in the petition, VTIP was tracking the maintenance fee due date(s) for the '514 patent and as the 01 May 2008 date was approaching for payment, Mark Coburn noted that the tracking report reflected the "Paid 8/9/06" entry and for this reason did not instruct the Whitham firm to pay the second maintenance fee.

The second point in the Decision states that

2. Petitioner has not provided statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them: a statement from the individual responsible for maintaining the docketing system at the Whitham law firm has not been located in the electronic file. (Decision, page 9 of 11.)

No one at the Whitham law firm was responsible for the delay. Michael Whitham at the Whitham law firm was responsible for maintaining the docketing system at the Whitham law firm. His Declaration (filed with the Petition on 23 January 2012) has been provided. Michael Whitham did not receive instructions to pay the '514 second maintenance fee and thus he (and the Whitham firm) had no responsibility for tracking and/or payment of this maintenance fee. No other person at the Whitham firm had any knowledge of (or responsibility for) the delay in payment of the second maintenance fee for the '514 patent. The docket system at Whitham was not relevant to the delay in payment of the second maintenance fee because Mark Coburn at VTIP was responsible and Mark had in place a reliable tracking system. As stated in Mark Coburn's declaration (filed with the Petition on 23 January 2012)

Just prior to about 01 May 2008 I implemented the appropriate commands to the Inteum C/S system to add maintenance fee docketing information to the Inteum C/S report. An Inteum C/S report was run and the accuracy of the US patent maintenance fee due dates was confirmed. Thereafter the Inteum C/S reports included the maintenance fee due date for the US patents that are assigned to VTIP. (Coburn Declaration, paragraph 2.)

We confirmed that Whitham, Curtis, Christofferson & Cook P.C. had paid all US patent maintenance fees that they were instructed to pay. (Coburn Declaration, paragraph 9.)

Accordingly, no instructions to pay the second maintenance fee were ever provided to the Whitham firm and there was no responsibility at the Whitham firm to pay the second maintenance fee. It is noted that the Decision at page 6 of 11 states in part that “Previous to 01 May 2008 the law firm of Whitham, Curtis, Christofferson & Cook P.C. (Whitham law firm) ‘was responsible for tracking and payment of maintenance fees for VTIP patents.’” The Decision is quoting from paragraph 5 of the Declaration of Mark Coburn. The accompanying Supplemental Declaration of Mark Coburn clarifies this point by referring to the statements in his previous declaration and explaining that “no one at the Whitham firm was responsible for payment of the second maintenance fee for the ‘514 patent because no instructions to pay the second maintenance fee for the ‘514 patent had been sent to the Whitham firm.” Until instructions were received at the Whitham firm to pay the second maintenance fee for the ‘514 patent no one at the Whitham firm was responsible for payment of this fee. Accordingly, there is no one at the Whitham firm with direct knowledge of the delay and no further statements from a person or persons at the Whitham firm are possible. In view of the above, it is submitted that statements by all persons with direct knowledge of the circumstances surrounding the delay and setting forth the facts as they know them have been provided.

The third point in the Decision states that

3. Petitioner has not provided a thorough explanation of the docketing and call-up system in use by VTIC, and has provided no explanation of the system in use by the Whitham firm. (Decision, page 9 of 11.)

The system in use by VTIP is the Inteum C/S System which is discussed in the Petition and in the Declarations of Mark Coburn and Debra Lucas (both filed with the Petition). As explained at paragraph 4 of Mark Coburn’s Declaration “Inteum C/S is recognized in the industry as an excellent management tool for tracking patent due dates including maintenance fee due dates and is in use at over 400 sites worldwide.” The Inteum C/S system is a computer tracking system that is widely used and information is publicly available via a Google search of the Internet for

“Inteum C/S.” A copy of information copied from the Internet site discussing the Inteum C/S system is attached hereto as Exhibit A. The system in use was simply Debra Lucas (the experienced and reliable docket clerk), the Inteum C/S system at VTIP and Mark Coburn. As stated at paragraph 6 of his supplemental declaration submitted with this request for reconsideration “[a]t the time of the error (on or about 8/9/06) Debra Lucas and I were the only persons responsible for entry of information into the VTIP tracking system (the Inteum C/S system used at VTIP).” Thus, petitioner has provided a thorough explanation of the docketing and call-up system at VTIP, namely petitioner has filed the statements of Debra Lucas and Mark Coburn and has filed an explanation of the Inteum C/S system at VTIP.

As explained in the Petition, beginning on or about 01 May 2008 VTIP generated a monthly report which was used to determine which maintenance fees could be paid (an example of the report accompanied the petition as Exhibit A). The Petition further explained that Mark Coburn reviewed the Inteum C/S report “to determine if any issue fee payment is beyond the due date (and into the grace period for payment with a surcharge).” (Petition, paragraph 3.) As stated in his supplemental declaration this review was performed at least monthly. Accordingly, the docketing and call-up system in use by VTIP during the time of delay in payment of the second ‘514 maintenance fee has been fully described.

Regarding the system in use by the Whitham firm, the Whitham firm was not responsible for the docketing error by VTIP paralegal Debra Lucas and the Whitham firm was not responsible for the failure to pay the second maintenance fee because the Whitham firm was not instructed to pay the second maintenance fee. The Whitham firm was also not responsible for the failure to pay the second maintenance fee because it did not employ Debra Lucas (she was employed at VTIP until June 2007) and the Whitham firm was not responsible for her docketing error which led to the failure to pay the second maintenance fee.

The fourth point in the Decision states that

4. Petitioner has provided an identification of the type of records kept by VTIC, but not the type of records kept by the Whitham firm. (Decision, page 9 of 11.)

As discussed above and in the Petition, the Whitham firm had no responsibility for the failure to pay the second maintenance fee in the ‘514 patent. Accordingly, there is no

information at the Whitham firm that has any relevant relation to the error and/or cause of the error (Debra Lucas docketing error) that led to the failure to pay the second maintenance fee.

The fifth point in the Decision states that

5. Petitioner has indicated that Ms. Lucas was responsible for the maintenance of the VTIP system, but has not provided an identification of the persons responsible for the maintenance of the system in use by the Whitham law firm; (Decision, page 9 of 11.)

As discussed above and in the Petition, the Whitham firm had no responsibility for the failure to pay the second maintenance fee in the '514 patent. Michael Whitham at the Whitham law firm was responsible for maintaining the docketing system at the Whitham law firm. His Declaration (filed with the Petition on 23 January 2012) has been provided. Michael Whitham had no knowledge of the delay in payment of the second maintenance fee for the '514 patent and no other person at the Whitham firm had any knowledge of the delay in payment of the second maintenance fee for the '514 patent. Accordingly, there is no information at the Whitham firm that has any relevant relation to the error and/or cause of the error (Debra Lucas docketing error) that led to the failure to pay the second maintenance fee.

The sixth point in the Decision states that

6. Petitioner has provided a copy of the records which would substantiate an error in docketing during the period of time when VTIP was responsible for the tracking of the 7 1/2 year maintenance fee, but has not provided copies of mail ledger, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing during the period of time when the Whitham law firm was responsible for the tracking of the 7 1/2 year maintenance fee; (Decision, page 9 of 11.)

The request for "mail ledger, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing during the period of time when the Whitham law firm was responsible for the tracking of the 7 1/2 year maintenance fee" asks for records at the Whitham firm that "would substantiate an error in docketing." As discussed above and in the Petition, the Whitham firm had no responsibility for the failure to pay the second maintenance fee in the '514 patent and the docketing error occurred at VTIP, not at Whitham.

Debra Lucas was employed at VTIP, not by the Whitham firm. Accordingly, there is no information at the Whitham firm that has any relevant relation to the error and that “would substantiate an error in docketing” (the docketing error by Debra Lucas at VTIP that led to the failure to pay the second maintenance fee).

The seventh point in the Decision states that

7. Petitioner has provided an indication as to why the system failed in this instance during the time period when VTIP was responsible for the tracking of the 7 ½ year maintenance fee, but not for the period of time when the Whitham law firm was responsible for the tracking of the 7 ½ maintenance fee; (Decision, page 9 of 11.)

As discussed above and in the Petition, the VTIP system failure resulted from the erroneous “Paid 8/9/06” entry by Debra Lucas while she was employed at VTIP. As explained in the Declaration of Mark Coburn (submitted with the Petition) it was this error that misled him into believing that the second maintenance fee had been paid. There was no error at the Whitham firm, no one at the Whitham firm has any knowledge of Debra’s error. Accordingly, it is not possible to provide information of a system failure or other failure at the Whitham firm.

The eighth point in the Decision states that

8. Petitioner has not provided information regarding the training provided to either Ms. Lucas or the unnamed individual responsible for the docketing error at the Whitham law firm; (Decision, page 10 of 11.)

Debra Lucas training is discussed at paragraphs 2 and 3 of her Declaration (filed with the Petition on 23 January 2012) and is discussed at paragraph 14 of Mark Coburn’s Declaration (filed with the Petition on 23 January 2012). Mark Coburn’s extensive experience with patent processing generally and tracking patent due dates via Inteum C/S is discussed in the Petition and in his declaration. Mark Coburn’s declaration also attests to the extensive experience and training of Debra Lucas with patent processing generally and tracking patent due dates via the VTIP Inteum C/S system. The details provided demonstrate that Debra Lucas is experienced with regard to the function of monitoring of patent due dates such that reliance upon Debra

Lucas and the VTIP Inteum C/S system for payment of VTIP's US patent maintenance fees represented the exercise of due care.

In Mark Coburn's supplemental declaration (submitted with this request for reconsideration) Mark further explains that

Regarding Debra Lucas training and supervision (reason Nos. 8-11 at page 10 of 11 of the Decision), Debra was fully trained in use of the Inteum C/S system at VTIP and she had responsibility for other patent related tasks including communications with inventors, attorneys and the USPTO. Debra reported directly to me and as Debra's supervisor I hereby attest that I periodically reviewed her work and found it to be of the highest quality. Debra received information about any process changes or possible changes, e.g., notices from Inteum about possible changes to the Inteum C/S system and she was adept at understanding such notices and implementing anything new when required. Debra's work was regularly reviewed by me and she had regular (at least annual) performance evaluations. Debra did not make mistakes and any patterns of error would have been noticed. None were. (Mark Coburn's supplemental declaration at paragraph 8.)

Michael Whitham at the Whitham law firm was responsible for maintaining the docketing system at the Whitham law firm. His Declaration (filed with the Petition on 23 January 2012) has been provided. Michael Whitham has no knowledge of or responsibility for the delay in payment of the second maintenance fee for the '514 patent and no other person at the Whitham firm has any knowledge of or responsibility for the delay in payment of the second maintenance fee for the '514 patent. Accordingly, there is no relevant training information for anyone at the Whitham firm and no one at the Whitham firm has any relevant information relative to the error and/or cause of the error (Debra Lucas docketing error) that led to the failure to pay the second maintenance fee.

The ninth point in the Decision states that

9. Petitioner has not explained the degree of supervision of Ms. Lucas' work, and no mention is made of any supervision of the unnamed individual responsible for the docketing error at the Whitham law firm; (Decision, page 10 of 11.)

As discussed at paragraph 14 of Mark Coburn's Declaration (filed with the Petition on 23



January 2012 he is

the manager who supervised Debra Lucas from March of 2006 until she left VTIP in June of 2007. She was well trained and performed her work very well. Debra Lucas had worked at VTIP for several years prior to my arrival in March of 2006 and she had achieved a status of a trusted and reliable employee. She was familiar with the Inteum C/S data base and based on her work with me at VTIP I readily state that she was a reliable employee that could always be counted on to perform her duties correctly and on time. I am not aware of any other error made by Debra Lucas that resulted in entry of misinformation into the Inteum C/S data base so as to cause a US patent maintenance fee payment to be missed.

Similar information is provided in Mark Coburn's supplemental declaration. It is evident that Debra Lucas was well a well-trained and reliable employee while at VTIP.

As explained above, there was no "docketing error at the Whitham law firm" and no "individual responsible for the docketing error at the Whitham law firm" and thus it is not possible to explain the degree of supervision of any such person at the Whitham firm.

The tenth point in the Decision states that

10. No examples of other work functions carried out have been provided for either Ms. Lucas' or the unnamed individual responsible for the docketing error at the Whitham law firm; and (Decision, page 10 of 11.)

As confirmed in the Supplemental Declaration of Mark Coburn, Debra Lucas was responsible for tracking (including docketing) of US patent matters while employed at VTIP. As discussed above she was also responsible for other patent prosecution matters and she demonstrated a good understanding of all of the patent matters in her area of responsibility. VTIP is responsible for hundreds of US patent matters (patent applications and issued US patents) and such provided Debra Lucas with a variety of work and a good understanding of patent matters..

Regarding the unnamed individual at Whitham, as discussed above, there was no "docketing error at the Whitham law firm" and no "individual responsible for the docketing error at the Whitham law firm" and thus it is not possible to explain a work function of any such person at the Whitham firm.

The eleventh point in the Decision states that

11. Petitioner is silent as to any checks on the described work which were used to assure proper execution of assigned tasks in regards to either Ms. Lucas' or the unnamed individual responsible for the docketing error at the Whitham law firm; (Decision, page 10 of 11.)

The Declaration of Mark Coburn (filed with the Petition on 23 January 2012) and the Supplemental Declaration of Mark Coburn (submitted herewith) confirms that checks of Debra Lucas' work were performed on a regular basis to assure proper execution of assigned tasks. For example, Mark Coburn's Declaration (filed with the Petition on 23 January 2012) states at paragraph No. 14

As President of Virginia Tech Intellectual Properties I am the manager who supervised Debra Lucas from March of 2006 until she left VTIP in June of 2007. She was well trained and performed her work very well. Debra Lucas had worked at VTIP for several years prior to my arrival in March of 2006 and she had achieved a status of a trusted and reliable employee. She was familiar with the Inteum C/S data base and based on her work with me at VTIP I readily state that she was a reliable employee that could always be counted on to perform her duties correctly and on time. I am not aware of any other error made by Debra Lucas that resulted in entry of misinformation into the Inteum C/S data base so as to cause a US patent maintenance fee payment to be missed.

As discussed above, there was no "docketing error at the Whitham law firm" and no "individual responsible for the docketing error at the Whitham law firm" and thus it is not possible to explain checks of work which were used to assure proper execution of assigned tasks of a person at the Whitham firm.

#### Conclusion

The record shows that there were steps in place by VTIP to pay the maintenance fees for the '514 Patent. These steps included utilization of a reliable tracking system such as would be used by a prudent and careful person with respect to his most important business. Moreover, that system was administered by a highly competent person who was familiar with the maintenance fee tracking system, and who faultlessly tracked and timely paid many other

maintenance fees. In the present instance these steps were frustrated (as explained above) by the above-discussed docketing error. The UPSTO has long recognized that under the unavoidable delay standard, VTIP was and is entitled to rely upon the agency and instrumentality of such a worthy employee, and if, as here, she unforeseeably and unexpectedly erred in the performance of her duties, such *error* is reasonably considered to be unavoidable within the meaning of 35 U.S.C. §41(c) and 37 CFR §1.378(b).

The delay in payment of the second maintenance fee for the '514 Patent was unavoidable, and a proper showing under 37 C.F.R. §1.378(b) has been made. Accordingly, a proper showing has been made that relief should be granted, that the payment tendered for the second maintenance fees should be accepted in the '514 Patent, and that such patent should be held in force. Therefore, it is respectfully requested that the unavoidable delay of the payment of the second maintenance fee for the '514 Patent be accepted and that this patent be reinstated.

The Commissioner is hereby authorized to charge any maintenance fees, surcharges, or any required additional fees (including any fee due under 37 CFR 1.17(f)), or credit any overpayment, to Deposit Account No. 02-1010, referencing Docket No. 55820-49375.

Any remaining questions may be directed to the undersigned.

Please direct the Decision in response to this Request For Reconsideration to the undersigned.

Respectfully submitted,



Richard B. Lazarus  
Reg. No. 48,215

Barnes & Thornburg LLP  
1717 Pennsylvania Ave. NW, Suite 500  
Washington, DC 20006

Telephone 202-289-1313

Attachments: Information copied from the Internet site discussing the Inteum C/S system.

## Exhibit A

(A copy of information copied from the Internet site discussing the Inteum C/S system.)



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